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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,927	02/19/2002	David W. Smith		1842

7590 04/11/2003

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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/11/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,927

Applicant(s)

SMITH ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g., D, G, E, J, etc., and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I, claim(s) 1-6 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl,

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted phenyl

And their methods of use

Group II, claim(s) 1, 7 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted naphthalene

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Group III, claim(s) 1, 8 and 20-26 drawn to products of the formulas as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted phenyl

J is H or lower alkyl

Group IV, claim(s) 1, 9 and 20-26 drawn to products of the formulas as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted thiazolyl

Group V, claim(s) 1, 10 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E and J form a naphthalenyl

G is substituted or unsubstituted phenyl

Group VI, claim(s) 1, 11 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is H or lower alkyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted phenyl

Group VII, claim(s) 1, 12 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is a naphthalenyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted phenyl

Group VIII, claim(s) 1, 13 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substitute or unsubstituted indene

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted phenyl

Group IX, claim(s) 1, 14 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

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E is substituted or unsubstituted thiazolyl

G is substituted or unsubstituted phenyl

J is substituted or unsubstituted phenyl

Group X, claim(s) 1, 15 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is H or lower alkyl

J is substituted or unsubstituted phenyl

Group XI, claim(s) 1, 16 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted indene

J is substituted or unsubstituted phenyl

Group XII, claim(s) 1, 17 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted ester

J is substituted or unsubstituted phenyl

Group XIII, claim(s) 1, 18 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted naphthalenyl

J is substituted or unsubstituted phenyl

Group XIV, claim(s) 1, 19 and 20-26 drawn to products of the formula as found in claim 1 wherein:

D is H or lower alkyl

E is substituted or unsubstituted phenyl

G is substituted or unsubstituted $-(\text{CHR}_1)_n\text{-O}-(\text{CHR}_2)_m\text{-CONR}_3\text{R}_4$ wherein R₁, R₂, R₃ and R₄ are H or substituted or unsubstituted alkyl

J is substituted or unsubstituted phenyl

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single

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invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same. The applicant may also choose to elect a single disclosed species and the examiner will endeavor to create a group comprising the elected species.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a sulfonamide moiety, which does not define a contribution over the prior art (as can be seen by WO 98/03166 provided by applicant). The substituents on the sulfonamide vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

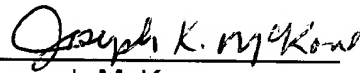
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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